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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,669	12/29/2000	David D. Koester	S01.12-0697	8902

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EXAMINER

CHEN, TIANJIE

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/751,669

Applicant(s)

KOESTER ET AL.

Examiner

Tianjie Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 19-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Non-Final Rejection***

1. The indicated finality of last Office action is withdrawn in view of the newly discovered reference(s) to Hyde (5,894,382) and Born et al (US 5,930,581). Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al (US 6,538,853).

With regard to claim 13, Williams et al shows an actuator in Fig. 1B, with external peripheral surface extending along an entire periphery of the actuator and including a desired profile dimension entirely defined by the external peripheral surface.

Williams does not show the method used for forming the peripheral surface. However, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations

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omitted) (Claim was directed to a novolac color developer. The process of making the developer was allowed. The difference between the inventive process and the prior art was the addition of metal oxide and carboxylic acid as separate ingredients instead of adding the more expensive pre-reacted metal carboxylate. The product-by-process claim was rejected because the end product, in both the prior art and the allowed process, ends up containing metal carboxylate. The fact that the metal carboxylate is not directly added, but is instead produced in-situ does not change the end product (MPEP § 2113 [R-1]).

3. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Wood et al (US 6,038,105).

With regard to claim 13, Wood et al shows an actuator 115, with machined external peripheral surface extending along an entire periphery of the actuator and including a desired profile dimension entirely defined by the machined external peripheral surface (Fig. 2; column 4, lines 53-54).

Although Wood et al shows the actuator is machined, as shown above, in a product-by process claim, the process related limitation, in this claim is limitation "machined," still does not earn weight in determining patentability.

4. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Born et al (US 5,930,581).

With regard to claim 13, Born et al shows an actuator in Fig.1, wherein the actuator is machined from 2.5 by 5.25 cm tape, which has machined external peripheral surface extending along an entire periphery of the actuator and including a

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desired profile dimension entirely defined by the machined external peripheral surface (Column 9, lines 33-54).

Although Wood et al shows it is machined, as shown above, in a product-by process claim, the process related limitation, in this claim is limitation "machined" still does not earn weight in determining patentability.

5. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Hyde (US 5, 894,382).

With regard to claim 13, Hyde shows an actuator in Fig. 3, which is machined from a single piece of rigid light-weight metal (Column 5, lines 2-4), which has machined external peripheral surface extending along an entire periphery of the actuator and including a desired profile dimension entirely defined by the machined external peripheral surface.

Although Hyde shows it is machined, as shown above, in a product-by process claim, the process related limitation, in this claim is limitation "machined" still does not earn weight in determining patentability.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al/Wood et al/Born et al/ Hyde in view of Brar et al (US 5,156,919).

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Williams et al/Wood et al/Born et al/ Hyde et al shows an actuator as described above, wherein the external peripheral surface is machined, but Williams et al/Wood et al/Born et al/ Hyde is silent on the tolerance of the dimension of the surface.

Bar et al shows an actuator with a carriage, which is machined to a tolerance of about 0.003 inches (Column 5, lines 59-60).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to set the tolerance to 0.003 inches as taught by Brar et al. the rationale is as follows: in machining, a tolerance is inherent, but Williams et al/Wood et al/Born et al/ Hyde does not specify it. One of ordinary skill, in the art would have been searching for the tolerance. Brar et al shows a carriage of an actuator having a tolerance of 0.003 inches, which is less than 0.005 inches. And it is well known in the art that this tolerance is commonly achievable at the time the invention was made. One of ordinary skill in the art would have been motivated to set the tolerance in Wood et al's device to 0.003 inches as taught by Brar et al. In such constructed device, the tolerance is less than 0.005 inches.

***Allowable Subject Matter***

7. Claims 19-21 are allowed.

The following is an examiner's statement of reasons for allowance:

- With regard to claim 19, as the closest reference, Wood et al (US 6,038,105) shows an actuator in a disk drive including a disc rotatable about a center axis including: an actuator means supporting and actuating an transducer relative to a disc and having a peripheral surface with a desired profile dimension within an inherent tolerance; **but fails to show** that the

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profile dimension with a tolerance is defined for limiting variation in resonance characteristics of the actuator means.

- Applicant asserts that this invention is to improve tolerances and thereby to reduce variation in resonance characteristics (Specification, p. 3, lines 23-25).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

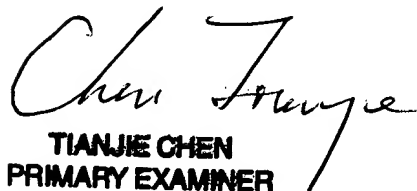
8. Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tianjie Chen whose telephone number is (703) 305-7499. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**TIANJIE CHEN**  
**PRIMARY EXAMINER**